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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,258	03/09/2001	Edgar H. Callaway JR.	CM03551J	8127

7590 01/04/2005

Daniel K. Nichols
Motorola, Inc.
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Fort Lauderdale, FL 33322

EXAMINER

LIU, SHUWANG

ART UNIT	PAPER NUMBER
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2634

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,258

Applicant(s)

CALLAWAY ET AL.

Examiner

Shuwang Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 09/01/04, with respect to the rejections of claims 1, 5, 6, 8, 15, 18, 19, 23, 24, 27, 34 and 36 under 35 USC 102 have been fully considered and are persuasive. The rejection of above claims under 35 USC 102 has been withdrawn.

2. Applicant's arguments regarding the double patent rejection under 35 USC 101 filed 09/01/04 have been fully considered but they are not persuasive except for claims 18-22.

Applicant's argument – "These claims have the limitation of **determining a first cyclical shift based on a bit pattern of the one or more bits**.Analysis of co-pending application 10/198, 712 reveals that this feature is neither taught nor suggested. In fact, **none of the claims even mentions a cyclical shift**."

Examiner's response – It is a crystal clear to show that not only claims of co-pending application 10/198,712 mentions "a cyclical shift" but also the words of claims of co-pending application 10/198,712 are identical with the words of the rejected claims, for example, the rejected claim 8 and claim 9 of co-pending application 10/198,712 are identical. Although rejected claim 1 was amended, the amended limitation is inherent for the claim 1 of co-pending 10/198,712. The examiner received a terminal disclaimer filed on 10/06/04. However, the filling of the terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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3. Claims 1, 2, 8, 18,, 27, and 38 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of patent No. 6,519,275 in previous office action. However, there is no response to the rejection. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions.

Specification

4. The disclosure is objected to because it is hard to understand that "The second pulse shaper 214 generates a second baseband signal based on a second PN code stored in the second PN memory 210" as disclosed on page 6, lines 8-9. How can the second PN code along generate the second baseband signal?

Claim Objections

5. Claims 18-22 are objected to because of the following informalities:

In claim 18, line 7, insert - -predetermined- - before "relative".

Appropriate correction is required.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1- 17 and 23-38 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 5-18, 2-40 of copending Application No. 10/198,712, respectively. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 2, 8, 27, and 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 of patent No. 6,519,275. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broader application claims would have been obvious in view of the narrow issued claims (see *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 18-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28 of co-pending application No. 10/198,712. Although the conflicting claims are not identical, they are not patentably distinct from each other because the broader application claims would have been obvious in view of the narrow issued claims (see *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuwang Liu whose telephone number is 571 272-3036. The examiner can normally be reached on M-F, 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on 571 272-3056. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shuwang Liu
Primary Examiner
Art Unit 2634

December 30, 2004